REMARKS AND ARGUMENTS

The final Office Action dated December 2, 2008 has been carefully reviewed, together with the claims of the captioned application and the new prior art cited in the rejection of the claims. For the reasons set forth below it is believed that the claims of the application are patentable over the prior art of record.

Status of the Claims

Claims 1-15 and 21-25 and 27 are fully allowed.

Claim 26 is rejected over the prior art.

Third Notice of Appeal

A third Notice of Appeal is being filed concurrently herewith, together with a Pre-Appeal Brief Request for Review and Issues for Review.

Claim Objections

Claims 1 and 26 have been objected to because the phrase "to thereby affect said engine accordingly" should be deleted. Claims 1 and 26 have been amended as suggested by the Examiner. Claim 26 has also been amended to insert the word "in" to clarify the meaning.

Rejections Under 35 U.S.C. § 102(e)

Claim 26 has been rejected under 35 U.S.C. §102(e) as being anticipated by Shelor et al (2003/0005913), hereafter "Shelor." In order for a prima facie case of anticipation to be established, all the limitations of the claimed invention must be disclosed in a single reference. See *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir.1994).

I. Claim 26 includes the limitation "providing aftermarket apparatus mounted to the engine ...."

In the Shelor reference, the Examiner considers the claimed aftermarket apparatus to be the diesel fuel cooler identified by numeral 15 in Fig. 1a of Shelor. It is submitted that the diesel fuel cooler of the Shelor reference is not mounted to the engine as claimed.

In paragraph [0004] of the reference, the problem that is solved by Shelor is described. The fuel injectors that inject the diesel fuel into the cylinders of the diesel engine heat the fuel, because the heat from the engine heats the injectors and the heated injectors heat the fuel. Accordingly, the unused fuel that is not injected into the cylinders of the engine, but is recirculated, is heated before it is returned to the fuel tank. When diesel fuel becomes too hot it can cause undesirable results. Shelor solved the problem of reducing the heat of the recirculated diesel fuel by using a fuel cooler to cool the fuel before directing the same back to the fuel injectors. The fuel cooler is of the heat exchanger type, or the type that is connected to the air-conditioner system of the vehicle. See paragraph [0022].

The Shelor reference does not disclose or suggest that the fuel cooler is mounted to the engine, as claimed. In the description and the drawings of the Shelor reference, there is expressly disclosed and shown the apparatus that is connected to the engine and that which not connected to the engine. The fuel tank is described as being remotely located from the engine [0019] and shown as such in Fig. 1a. The fuel pump 6 is described as located on or in near proximity to the engine [0019] and shown in Fig. 1a as being part of the engine 4 together with the fan. The fuel injector system 7 is also described as being mounted to the engine 4, and is shown in Fig. 1a as such. Fig. 1a illustrates the fuel return line 8 that caries fuel away from the engine 4 and the fuel feed line 5 that comes from the tank 2 to the engine 4.

The fuel cooler 15 is not shown or described as mounted to the engine 4, but is shown removed from the engine in the same manner as the other apparatus, such as the tank 2. Thus, it

is clear from the description and the drawings that the fuel cooler 15 is not mounted to the engine as claimed.

From the teachings of the Shelor reference, it is inherent that the cooler would not be mounted to the engine, as that would be counterproductive to the desired results, namely, to cool the fuel. In paragraph [0004] of the reference, the problem of excessively heating the fuel arises from the heat of the engine itself and apparatus mounted to the engine. Thus, the one place where one skilled in the art would not want the cooler to be mounted is on the engine. Heat exchange type coolers carry the fluid to be cooled to a location where the temperature is cooler than where the fluid was heated, otherwise the goal of cooling would not be achieved. For example, the radiator of an engine is located away from the engine and in front thereof where the air intake is cooler than the engine itself, thereby cooling the coolant before routing the same back to the engine.

The Shelor reference also suggests that the cooler could be connected to the air-conditioning system of the vehicle. Again, one skilled in the art would not mount the cooler on the source of heat with, for example the air conditioner compressor, but at a location that is cooled by the air of the air conditioner, such as a cooled compartment.

From the foregoing, the description and the drawings of the Shelor reference support Applicants' position, and not the position of the Examiner where it is stated that the cooler is mounted to the engine. The Examiner does not indicate where in the Shelor reference there is support for such a position.

The Examiner has the initial burden of establishing a prima facie case of anticipation. In meeting the burden, the Examiner must produce sufficient *evidence* that a reasonable person could accept as establishing the fact asserted. The Examiner must also meet the burden of *persuasion* to produce reasoning that establishes it is more likely than not that the claim is anticipated. The Examiner has not met the burden on either requirement, and cannot, as the cited

reference does not suggest the assertion of the Examiner. Indeed, the Examiner has not attempted to even articulate where the reference supports the rejection of the claim limitation at issue.

II. Claim 26 also specifies a method of demonstrating the affect of aftermarket apparatus on the performance of the engine (preamble) and providing an indication of the affect thereof on the engine performance.

The dictionary definition of the word "demonstration" which is consonant with the usage of the word in the captioned application, is "a showing of the merits of a product or service to a prospective consumer." Webster's Ninth New Collegiate Dictionary, 1984.

In the rejection, the Examiner simply repeats the limitations of claim 26 as to the method of demonstration, without pointing out where the demonstration occurs in the reference. The Examiner points to the thermostatic controller 13 as the element that provides the claimed indication of the affect on the engine performance by the cooler. It is believed that this position is not tenable and is not supported by the reference for the following reasons.

Claim 26 specifies a method of demonstrating the affect on engine performance when the aftermarket is switched into and out of operation, and there is provided an indication of such affect. While the thermostatic controller 13 of Shelor is effective to control the two-way valve 9, all operations are automatic and thus transparent to any user or observer. The thermostatic controller 13 senses the temperature of the fuel and automatically controls the valve 9 to achieve the cooling and recirculation of the cooled fuel. In order to provide a demonstration of the effect of the cooler switched into and out of operation, someone has to appreciate the affect of the same in order for there to be a demonstration at all. As noted above, all operations of the thermostatic controller 13 and the operation of the other controlled apparatus of the Shelor reference is all transparent to any user or operator, and thus there is no demonstration, as claimed, and no affects of the demonstration are provided.

While the Examiner asserts that the thermostatic controller 13 senses the temperature of the fuel to provide an effect on the engine performance by cooling the fuel, the thermostatic controller does not provide an indication of the effect on the engine performance. Stated another way, when the thermostatic controller does reconfigure the fuel system to cool the fuel, who knows that the same is happening, or who knows what the result is in order for the effect to be demonstrated by providing an indication of the effect. If nobody is aware of what is happening, how can there be a demonstration of the effect on engine performance. If the driver of the vehicle, or a bystander observer were viewing the vehicle while operating with the Shelor fuel cooler, or otherwise aware of it, how could they tell if the cooler was in operation or out of operation, or how would they know the performance of the engine was affected by the operation of the cooler. If nobody is aware of anything happening, there can be no demonstration.

From the foregoing, for this additional reason, the Examiner has not established a prima facie case of anticipation.

Conclusion

In view of the foregoing, the Examiner is respectfully requested to reconsider the rejections of the claims and grant full allowance of the application.

Respectfully submitted,
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